REMARKS/ARUMENTS

Claims 68, 138 and 142-186 are pending in the instant application. *No new matter has been added.*

Amendment and cancellation of the claims at any time during the prosecution of this application are not to be construed as acquiescence to any of the objections/rejections set forth in the instant Office Action or any previous Office Action, and are done solely to expedite prosecution of the application. Applicants submit that claims were not added or amended during the prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, or similar claims, in this or one or more subsequent patent applications.

Rejection under 35 U.S.C. § 103

Rejection of Claims 68, 138, 142, and 145 under 35 U.S.C. § 103(a)

Claims 68, 138, 142, and 145 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abdul-Ghani *et al.*, Brain Research (1996). In particular, the Office Action suggests, on page 3, that the reference "teaches the use of an 3-aminopropylarsonate compound that is analogous to compounds involved in the instant method of use..." Moreover, the Office Action suggests that

> the instant claims differ from the reference claims by having a two carbon spacer group separating the amino group and the anionic group as compared to the reference compound wherein there is a three carbon spacer...One having ordinary skill in the art would have been motivated to use a compound which is analogous to the reference disclosed anti-convulsant compound because such structurally analogous compounds would be expected to possess similar utilities.

Applicants respectfully traverse this rejection. Applicants submit that it is unclear how the prior art species of Abdul-Ghani *et al.* makes the ***entire genus structures*** of claims 68, 138, 142 or 145 obvious; or how the ***entire genus structure*** is a homolog of a single species in accordance with the definition described in MPEP § 2144.09. Applicants also submit that suggesting that a species that is not encompassed by a claimed generic structure makes obvious the entire generic structure, appears incongruent with MPEP § 2144.09. Furthermore, Applicants respectfully point out the language of MPEP § 2144.09, which states that "...homologs which are far removed from adjacent homologs may not be expected to have similar properties." This language clearly indicates that a genus structure, which is not confined to adjacent homologs, is not prima facie obvious in light of a prior art species. As the instant claims are not confined to the adjacent homologs of the species disclosed in Abdul-Ghani *et al.* (*e.g.*, numerous substituents for the amino group as well as the two-carbon spacer are recited in the pending claims) Applicants submit that the genus structure is not prima facie obvious in light of the prior art species.

Moreover, Applicants respectfully point out that as required by U.S.C. §103(a), the Examiner must demonstrate that

> ...the differences between the subject matter sought to be patented and the prior art are such that ***the subject matter as a whole*** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains...(Emphasis added)

In this respect, the Office Action has failed to show that the ***entire claim*** is obvious in light of the prior art reference, nor to provide any additional prior art references, nor to indicate the skill in the art, which would make up for the deficiencies of the cited reference, *i.e.*, the Examiner has not shown that each and every element of the claimed invention is obvious in light of the supplied reference. Therefore, the Office Action has failed to provide a reference that would render obvious ***the subject matter as a whole***.

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Applicants also respectfully remind the Examiner of the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a), which are summarized as follows:

(1) Determining the scope and contents of the prior art.
(2) Ascertaining the differences between the prior art and the claims at issue.
(3) Resolving the level of ordinary skill in the pertinent art.
(4) Considering objective evidence present in the application indicating obviousness or nonobviousness.

In this regard, (1) the Office Action has determined that the scope of the prior art falls within the four corners of the disclosure of Abdul-Ghani *et al.* As acknowledged by the Examiner, the relevant content of the prior art disclosure is limited to single species (recited therein), and the Examiner has agreed that this species is not within the scope of the claims by virtue of the three-carbon linker. Accordingly, (2) ***the difference between the prior art and the pending claims at issue is the entire claimed invention***. In fact, no part of the prior art reference recites subject matter that falls within the scope of the claims of the instant application, let alone that would make the ***entire*** scope of the rejected claims obvious. (3) The level of ordinary skill in the pertinent art has not been relied upon by the Examiner, and as such, has not been resolved in the instant Office Action. However, Applicants submit that the ordinarily skilled artisan would not have been in the possession of the ***entire*** claimed invention by the teachings of the prior art in conjunction with the level of ordinary skill in the pertinent art at the time the invention was made.

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In conclusion, it is Applicants assertion that the presently pending claims 68, 138, 142, and 145 are not rendered obvious by the disclosure of Abdul-Ghani *et al.* Accordingly, Applicants respectfully request withdrawal of the rejection of claims 68, 138, 142, and 145 under 35 U.S.C. §103(a) and favorable reconsideration.

Allowable Subject-Matter

Applicants appreciate the Examiner's acknowledgement of the allowability of the subject-matter of claims 143-144, and 146-186. However, Applicants submit that upon consideration of the arguments presented herein, claims 68, 138 and 142-186 are in condition for allowance.

CONCLUSION

In view of the foregoing remarks/arguments presented, favorable reconsideration and withdrawal of the rejections, and allowance of this application with all pending claims are respectfully requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-identified application, the Examiner is invited to call the undersigned at (617) 227-7400.

Respectfully submitted,

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